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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/208,814	12/09/1998	R. PADMANABHA RAO	939V-310-1-1	8650

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EXAMINER

HUYNH, SON P

ART UNIT PAPER NUMBER

2623

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/208,814	<b>Applicant(s)</b> RAO, R. PADMANABHA	
	<b>Examiner</b> Son P. Huynh	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005 and 03 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 60-62 and 65-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-62 and 65-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/04/05; 01/19/06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after Notice of Abandonment. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the Notice of Abandonment of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/04/2005 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 60-62, 65-68 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

3. Claims 60 - 62 and 65-68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable Rao (U.S. 5,940,738), in view of Herz et al. (US 5,351,075).

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Regarding claim 60, claim 15 of '738 recites a digital information distribution system comprising:

a digital information stream server comprising:

means for storing a digital information stream of predetermined duration;

network adaptation means for transmitting digital information onto a first communication network on a predetermined channel;

request receiving means for receiving requests for the digital information stream from the first communication network;

scheduling means for directing the digital information stream to the network adaptation

means for transmission over the first communication network on the predetermined

channel at a predetermined time, if a request for the digital information stream is

received by the request receiving means; and

opportunistic programming means for directing digital information to the network

adaptation means for transmitting over the first communication network only if the digital information stream is not being transmitted (see col. 25, line 1 – col. 26, line 7).

However, Claim 15 of '738 does not explicitly recite a “network interface” comprising:

request receiving means for receiving request originally for the subscriber units;

and

request relaying means for relaying only requests from privileged subscriber units for information stream to the information stream server; and

means for relaying information stream from the "first communication network" to the requesting ones of the privileged subscriber units via the "second communication network.

Herz et al. teaches a network interface (video program scheduler (60) and video selection and transmission unit 30 – figure 1) coupled to the first communication network (communication network between video library and video selection and transmission unit 30 – figure 1) for connecting the first communication network to a plurality of subscriber units (TVs 40 and phone 50 – figure 1) via a second communication network (network communication between TV 40, phone 50 and video selection and transmission unit 30, video program scheduler 60 – figure 1) comprising:

request receiving means (either video program scheduler 60 or interface of video selection and transmission unit 30 that interfaces with video program scheduler 60) for receiving request originally for the subscriber units (figure 1); and

request relaying means (interface in video selection and transmission unit 30 that interface with video library 20 – see figure 1) for relaying programming requests from subscriber units for the digital information stream to the digital information stream server (relaying the programming request to video library for requested video – figure 1); and means (interfaces in video selection and transmission unit 30 with TVs 40 – figure 1) for relaying the digital information stream from the first communication network (network between video library 20 and video selection and transmission unit 30) to the requesting ones of the subscriber units via the second communication network (network between

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video selection and transmission unit 30 and TVs 40 – figure 1). Herz further discloses the prerecorded video program stored in the video library 20 are made available to members of the Home Video Club (hereinafter “viewers”) **who have paid their membership fee by selecting the desired video programs using video selection and transmission unit 30**. Video program scheduler 60 specifies to the video selection and transmission unit 30 which video programs are to be selected from the video library 20 and at what times they are to be displayed (col. 3, lines 30-50; col. 4, line 68-col. 6, line 5, col. 7, lines 57-68). Since the video transmission selection and transmission unit send the request to video library (20) to retrieve the requested video and send to the viewers based on priority of the programming requests, it is obvious to one of ordinary skill in the art at the time the invention was made that the request relaying means (video selection and transmission unit interface with the video library) relaying only requests from privileged subscriber units for the digital information stream to the digital information stream server (only requests with higher priority are relayed to video library for requested video) so that only video with higher priority is selected and provided to the users at that time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 15 of '738 to use the teaching as taught by Herz in order at least to raise revenue (see col. 8, lines 36-44; abstract).

Regarding claim 61, claim 15 of '738 further recites the scheduling in the rejection of claim 60 further comprising means for:

if a request for the digital information stream is received prior to a predetermined time, initiating transmission of the digital information stream starting at a beginning of the digital information stream over the predetermined channel at the predetermined time; and

if the request for the digital information stream is received after the predetermined time, initiating transmission of the digital information stream at a point in the digital information stream determined relative to the predetermined time so that the digital information stream ends the predetermined duration after the predetermined time (see col. 24, lines 53-67).

Regarding claim 62, Herz further discloses communication network between video library (20) and video selection and transmission unit 30) – figure 1. Inherently, this communication network is a hierarchical network.

Regarding claim 65, claim 16 of '738 recites a digital information distribution system comprising:

a digital information stream server comprising:

means for storing a digital information stream of predetermined duration;

network adaptation means for transmitting digital information onto a first communication network on a predetermined channel;

request receiving means for receiving requests for the digital information stream from the first communication network;

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scheduling means for directing the digital information stream to the network adaptation means for transmission over the first communication network on the predetermined channel at a predetermined time, if a request for the digital information stream is received by the request receiving means; and

opportunistic programming means for directing digital information to the network adaptation means for transmitting over the first communication network only if the digital information stream is not being transmitted wherein the opportunistic program means transmits digital information via the channel only upon request of a subscriber unit when the digital information stream is not being transmitted (see col. 25, line 1-col. 26, line 12). However, Claim 16 of '738 does not explicitly recite a "network interface"

comprising:

request receiving means for receiving request originally for the subscriber units;

and

request relaying means for relaying only requests from privileged subscriber units for the digital information stream to the digital information stream server; and

means for relaying the digital information stream from the "first communication network" to the requesting ones of the privileged subscriber units via the "second communication network."

However, Claim 15 of '738 does not explicitly recite a "network interface" comprising:

request receiving means for receiving request originally for the subscriber units;

and



request relaying means for relaying only requests from privileged subscriber units for information stream to the information stream server; and

means for relaying information stream from the “first communication network” to the requesting ones of the privileged subscriber units via the “second communication network.

Herz et al. teaches a network interface (video program scheduler (60) and video selection and transmission unit 30 – figure 1) coupled to the first communication network (communication network between video library and video selection and transmission unit 30 – figure 1) for connecting the first communication network to a plurality of subscriber units (TVs 40 and phone 50 – figure 1) via a second communication network (network communication between TV 40, phone 50 and video selection and transmission unit 30, video program scheduler 60 – figure 1) comprising:

request receiving means (either video program scheduler 60 or interface of video selection and transmission unit 30 that interfaces with video program scheduler 60) for receiving request originally for the subscriber units (figure 1); and

request relaying means (interface in video selection and transmission unit 30 that interface with video library 20 – see figure 1) for relaying programming requests from subscriber units for the digital information stream to the digital information stream server (relaying the programming request to video library for requested video – figure 1); and means (interfaces in video selection and transmission unit 30 with TVs 40 – figure 1) for relaying the digital information stream from the first communication network (network

between video library 20 and video selection and transmission unit 30) to the requesting ones of the subscriber units via the second communication network (network between video selection and transmission unit 30 and TVs 40 – figure 1). Herz further discloses the prerecorded video program stored in the video library 20 are made available to members of the Home Video Club (hereinafter “viewers”) **who have paid their membership fee by selecting the desired video programs using video selection and transmission unit 30.** Video program scheduler 60 specifies to the video selection and transmission unit 30 which video programs are to be selected from the video library 20 and at what times they are to be displayed (col. 3, lines 30-50; col. 4, line 68-col. 6, line 5, col. 7, lines 57-68). Since the video transmission selection and transmission unit send the request to video library (20) to retrieve the requested video and send to the viewers based on priority of the programming requests, it is obvious to one of ordinary skill in the art at the time the invention was made that the request relaying means (video selection and transmission unit interface with the video library) relaying only requests from privileged subscriber units for the digital information stream to the digital information stream server (only requests with higher priority are relayed to video library for requested video) so that only video with higher priority is selected and provided to the users at that time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claim 15 of ‘738 to use the teaching as taught by Herz in order at least to raise revenue (see col. 8, lines 36-44; abstract).

Regarding claim 66, claim 15 of '738 in view of Herz teaches a system as discussed in the rejection of claim 60. Claim 15 of '738 further recites the opportunistic programming means transmits digital information to the network adaptation means for transmission over the first communication network only if the digital information stream is not being transmitted (see col. 24, lines 48-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made that the opportunistic programming means transmits digital information via the channel whenever the digital information stream is not being transmitted in order to reduce wasting of unused bandwidth.

Regarding claim 67, Claim 15 of '738 in view of Graves and McNamara teaches the system as discussed in the rejection of claim 60. Claim 15 of '738 further recites the opportunistic programming means transmits digital information to the network adaptation means for transmission over the first communication network only if the digital information stream is not being transmitted (see col. 25, lines 48-53). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to include an alternative video program in the digital information to provide video program to user.

Regarding claim 68, claim 15 of '738 in view of Herz teaches a system as discussed in the rejection of claim 60. Official Notice is taken that transmitting computer data in digital information is well known in the art. Therefore, it would have been obvious one of the ordinary skill in the art at the time the invention was made to modify claim 15 of '738

and Herz to use the well known teaching in the art in order to provide computer data to user.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Johnson et al. (US 5,001,554) discloses terminal authorization method.

Yurt et al. (US 5,132,992) discloses audio and video transmission and receiving system.

Hendricks et al. (US 5,600,573) discloses operations center with video storage for a television program packaging and delivery system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**It is noted that Group Art Unit 2611 has been changed to Group Art Unit 2623**

SPH

April 30, 2006

  
HAITRAN  
PRIMARY EXAMINER